



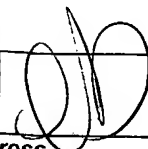
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,428	12/03/2001	Stephen M. Key	PA2321	1741
22830	7590	08/24/2004	EXAMINER	
CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/005,428	Applicant(s) KEY, STEPHEN M.	
	Examiner Daniel Zirker	Art Unit 1771	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 7/1/04 and 7/29/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: _____.

Claim(s) rejected: 24-26, 32-35, 41-52.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300
1700



NOTE

1. Upon reconsideration, the Examiner believes that the case in its present condition is not in condition for allowance as was set forth in the Advisory Action mailed 7/15/04 for the following reasons, in addition to those set forth in the pending Final Rejection.

2. With respect to the new matter based 35 U.S.C. § 112 first paragraph rejection set forth in paragraph No. 3 of the final rejection, the Examiner notes that incorporation by reference cannot incorporate by reference to various US patents essential subject matter as applicant is believed to have done in certain instances in the amendments to the specification and, more importantly, also materially change the existing disclosure such as was done in his prior Response in paragraph No. 2 on page 7 and also in paragraph No. 3 starting on page 8. As to applicant's insertion of the word "coupling" or "couples" in the specification, the Examiner has never seen this term used as being synonymous with adhesive bonding or the like, which is what applicant has attempted to do.

3. Concerning the rejection based upon a lack of an enabling written description such as set forth in the paragraph No. 3 on page 3 of the specification, it is believed that applicant's specification is seen to be little more than an

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invitation to experiment with respect to such elements as permanent or temporary adhesive, and also its characterization of "water", "static electricity", and "application of pressure" as apparently some sort of temporary adhesive which is clearly adverse to the normal meaning of the term.

4. With respect to the prior art rejection of record in addition to what has already been set forth it is noted that applicant's independent claim 4 is so broad as to read on only a well known transparent label (such as set forth in Barnum Jr. et al) having adhesive located in any of two differing locations on its back surface; such a structure is clearly not patentable. As to the various relied upon prior art combinations, it is submitted that each of these references are taken from the label art where rotatable labels are well known, such as set forth in Barnum, Jr. and one of ordinary skill would not be restricted to looking only at presently existing rotatable labels.

5. The Examiner notes that recently cancelled claims 39 and 40 may be reinserted by applicant if desired, since their cancellation was due to the Examiner's now withdrawn indication of allowability. Additionally, new dependent claim 52 will also be considered.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel

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Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

August 20, 2004